

REMARKS

The examiner respectfully rejected Claims 1-2 and 5-6 under 35 U.S.C. § 102(b) as being anticipated by Chou et al ('536).

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Differences exist between the invention claimed in Campbell and the currently claimed invention. Campbell teaches an umbrella having a ray emitting device which is visible in the darkness.

However, Chou et al, 1 fails to teach a translucent, *neon-colored tube* circumscribing the shaft of the umbrella, but rather teaches a "transparent, solid, polygonal rod", see Claim 1, Col. 2, line 50.

Therefore, in view of the aforementioned differences between Chaou et al and the present invention, the examiner's rejection of Claims 1-2 and 5-6 under 35 U.S.C. § 102(b) as being anticipated by Campbell is inappropriate.

The examiner respectfully rejected Claims 1-2 and 5 under 35 U.S.C. § 102(b) as being anticipated by Tatsumi ('831). Tatsumi teaches an illuminated umbrella having a light source in a handle or a shaft, thereby illuminating at least part of the shaft coupled to the handle.

However, Tatsumi fails to *specifically claim* an incandescent lamp; a neon-colored tube circumscribing the shaft of the umbrella; a series of threads formed along a lower rim of the handle; and a screw cap with matching, receiving threads to mate with the threads formed along the lower rim of the handle such as to removably contain the batteries.

Therefore, in view of the numerous differences that abound between Tatsumi and the present invention, the examiner's rejection of Claims 1-5 and 7 under 35 U.S.C. § 102(b) is inappropriate.

Further still, the examiner respectfully rejected Claims 3 under 35 U.S.C. § 103(a) as being unpatentable over Chouet al or Tatsumi in view of Murphy, and rejected claims 4 and 7 in view of Chou et al or Tatsumi in view of Carso et al.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(i).

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make

the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

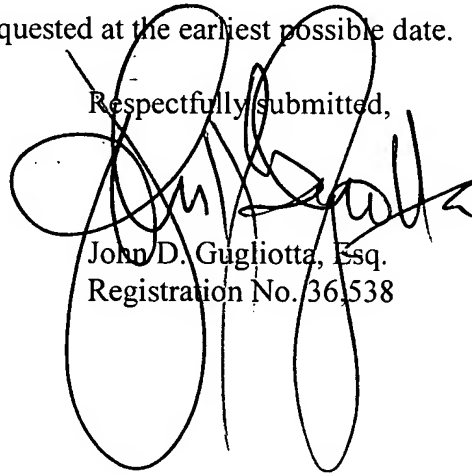
There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a, further comprising an umbrella having an illumination means housed within a handle section and having a translucent, neon-colored tube circumscribing said shaft of the umbrella. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also

In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'John D. Gugliotta', is written over the typed name and registration number.

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